

10/661,437

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Feldman et al.	Examiner:	Unknown
Serial No.:	10/661,437	Group Art Unit:	Unknown
Filed:	September 12, 2003	Docket No.:	12008.32USC6
		Confirmation No.:	8139

Title: SMALL VOLUME IN VITRO ANALYTE SENSOR

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop MISSING PARTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 18, 2005.

By: Rebecca Ralls

Name: Rebecca Ralls

PETITION TO ACCEPT PAPERS

Mail Stop MISSING PARTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

On May 13, 2005, a Notice of Omitted Item(s) in a Nonprovisional Application was mailed by the Patent Office. This Notice indicates that Figures 18A-C were omitted from, yet described in, the application. A copy of the Notice is enclosed. Applicants contend that Figures 18A-C were indeed submitted on September 12, 2003, the original filing date of the application.

The three figures, Figures 18A-C, are on one drawing sheet. The drawing sheet is the 16th of 28 total sheets that were filed.

Enclosed a photocopy of the original transmittal document that was filed on September 12, 2003. The transmittal document indicates that 28 sheets of formal drawings were filed.

Enclosed is a photocopy of the return postcard that was submitted with the application, and which was stamped as received by the Patent Office. This postcard indicates that 28 sheets of formal drawings were filed.

Enclosed is a photocopy of drawing sheet 16 of 28 from Applicants' attorney's file, showing Figures 18A-C. This photocopy is a true copy of what was filed on September 12,

05/24/2005 ENHAILE1 00000054 10661437

01 FC:1462

400.00 OP

2003. One will see the drawing label at the top of the sheet that identifies the application. (Applicants' attorney apologizes that the holes for holding the sheet in the file were punched through the "16 of 28".)

Additionally, the transmittal document, on page 2, under section 1., states that the entire disclosure of the prior application, which includes the figures, is considered as being part of the disclosure of the application and is incorporated by reference.

Applicants contend that Figures 18A-C were submitted on September 12, 2003.

Enclosed herewith is a check for \$400.00 for the petition fee. Applicants request a refund of this fee when it is determined that Figures 18A-C were indeed originally submitted.

Applicants note that a Notice Under 37 CFR 1.251 dated May 12, 2005 was received; this Notice indicates that the Drawings submitted on September 12, 2003 could not be located at the PTO after a reasonable search. Submitted on even date with this petition is a replacement set of formal drawings in response to the Notice Under 37 CFR 1.251, the drawings being sent to Mail Stop DUPLICATES. These formal drawings are a complete and accurate copy of Applicants' Attorney's record, and include 28 sheets of drawings, including sheet 16 which has Figures 18A-C thereon.

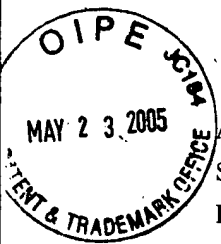
Respectfully submitted,

MERCHANT & GOULD P. C  
P. O. Box 2903  
Minneapolis, Minnesota 55402-0903  
(612) 371-5222

Date: May 18, 2005

By Mara E. Liepa  
Mara E. Liepa  
Reg. No. 40,066  
MEL:rlr





IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: FELDMAN ET AL. Examiner: UNKNOWN  
Serial No.: 10/661,437 Group Art Unit: UNKNOWN  
Filed: SEPTEMBER 12, 2003 Docket: 12008.32USC6  
Confirmation No.: 8139  
Title: SMALL VOLUME IN VITRO ANALYTE SENSOR

CERTIFICATE UNDER 37 CFR 1.8:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Missing Parts, Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 on May 18, 2005.

By: Rebecca Ralls  
Name: Rebecca Ralls

Mail Stop Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**23552**  
PATENT TRADEMARK OFFICE

Sir:

We are transmitting herewith the attached:

- ☒ Transmittal Sheet in duplicate containing Certificate of Mailing
- ☒ Notice of Omitted Item(s) in a Nonprovisional Application (Part 2)
- ☒ Check(s) in the amount of \$400.00 for Petition Fee
- ☒ Copy of Originally filed: Transmittal, Postcard, and Figure 18A-18C (sheet 16)
- ☒ Return postcard

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers or any future reply, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate of this sheet is enclosed.

Merchant & Gould P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903  
612.332.5300

By: Mara E. Liepa  
Name: Mara E. Liepa  
Reg. No.: 40,066  
MELIEPA:rlr

HFW



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/661,437	09/12/2003	Benjamin J. Feldman	12008.32USC6

Attention: Mara E. Liepa  
 MERCHANT & GOULD P.C.  
 P.O. Box 2903  
 Minneapolis, MN 55402-0903



CONFIRMATION NO. 8139

## FORMALITIES LETTER



\*OC000000016019597\*

Date Mailed: 05/13/2005

## NOTICE OF OMITTED ITEM(S) IN A NONPROVISIONAL APPLICATION

## FILED UNDER 37 CFR 1.53(b)

A filing date has been accorded to the above-identified nonprovisional application papers; however, the following item(s) appear to have been omitted from the application:

- Figure(s) **18A-C** described in the specification.

I. Should applicant contend that the above-noted omitted item(s) was in fact deposited in the U.S. Patent and Trademark Office (USPTO) with the nonprovisional application papers, a copy of this Notice and a petition (and \$400.00 petition fee (37 CFR 1.17(f))) with evidence of such deposit **must** be filed within **TWO MONTHS** of the date of this Notice. The petition fee will be refunded if it is determined that the item(s) was received by the USPTO.

II. Should applicant desire to supply the omitted item(s) and accept the date that such omitted item(s) was filed in the USPTO as the filing date of the above-identified application, a copy of this Notice, the omitted item(s) (with a supplemental oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items), and a petition under 37 CFR 1.182 (with the \$400.00 petition fee (37 CFR 1.17(f)) requesting the later filing date **must** be filed within **TWO MONTHS** of the date of this Notice.

Applicant is advised that generally the filing fee required for an application is the filing fee in effect on the filing date accorded the application and that payment of the requisite basic filing fee on a date later than the filing date of the application requires payment of a surcharge (37 CFR 1.16(f)). To avoid processing delays and payment of a surcharge, applicant should submit any balance due for the requisite filing fee based on the later filing date being requested when submitting the omitted item(s) and the petition (and petition fee) requesting the later filing date.

III. The failure to file a petition (and petition fee) under the above options (I) or (II) within **TWO MONTHS** of the date of this Notice (37 CFR 1.181(f)) will be treated as a constructive acceptance by the applicant of the application as deposited in the USPTO. **THIS TWO MONTH PERIOD IS NOT EXTENDABLE UNDER 37 CFR 1.136(a) or (b).** In the absence of a timely filed petition in reply to this Notice, the application will maintain a filing date as of the date of deposit of the application papers in the USPTO, and original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the USPTO on the date of deposit.

In the event that applicant elects not to take action pursuant to options (I) or (II) above (thereby constructively electing option (III)), amendment of the specification to renumber the pages consecutively and cancel incomplete sentences caused by any omitted page(s), and/or amendment of the specification to cancel all references to any omitted drawing(s), relabel the drawing figures to be numbered consecutively (if necessary), and correct the

references in the specification to the drawing figures to correspond with any relabeled drawing figures, is required. A copy of the drawing figures showing the proposed changes in red ink should accompany with any drawing changes. Such amendment and/or correction to the drawing figures, if necessary, should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

Replies should be mailed to: Mail Stop Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

---

*A copy of this notice **MUST** be returned with the reply.*



---

Office of Initial Patent Examination (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE



Receipt is hereby acknowledged for the following in the U.S. Patent and Trademark Office:

M&G 12008.32USC6 Applicant: Feldman et al.

"Express Mail" #: EV347831335US

Date of Deposit: September 12, 2003

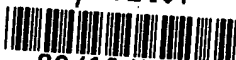
- ☒ a request for filing a continuation application under 37 CFR § 1.53(b)
- ☒ The application is as follows: 98 pages of specification, 17 claims, 1 page of abstract, 28 sheets of drawings, and 5 pages of oath or declaration.
- ☒ Attached is a check in the amount of 740.00
- ☒ A set of formal drawings (28 sheets) is enclosed

Patent Application

MELIEPA:rlr

03916 U.S. PTO

10/661437



09/12/03



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DOCKET NUMBER	ANTICIPATED CLASSIFICATION OF THIS APPLICATION:		PRIOR APPLICATION	
	CLASS	SUBCLASS	EXAMINER	ART UNIT
12008.32USC6	029	831000	NGUYEN, DONGHAID	3729

**CERTIFICATE UNDER 37 CFR 1.10:**

"Express Mail" mailing label number: EV347831335US

Date of Deposit: September 12, 2003

I hereby certify that this paper or fee is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Mail Stop Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By:

*Teresa Anderson*  
Name: Teresa Anderson

CONTINUATION APPLICATION UNDER 37 C.F.R. § 1.53(b)

Mail Stop Patent Application  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is a request for filing a continuation application under 37 CFR § 1.53(b) of Serial No. 09/594,285, filed on June 15, 2000 entitled METHOD OF MANUFACTURING SMALL VOLUME IN VITRO ANALYTE SENSOR by the following inventor(s):

<b>Full Name Of Inventor</b>	<b>Family Name</b>	<b>First Given Name</b>	<b>Second Given Name</b>
	FELDMAN	BENJAMIN	J.
<b>Residence &amp; Citizenship</b>	<b>City</b>	<b>State or Foreign Country</b>	<b>Country of Citizenship</b>
	OAKLAND	CALIFORNIA	USA
<b>Post Office Address</b>	<b>Post Office Address</b>	<b>City</b>	<b>State &amp; Zip Code/Country</b>
	5830 COLBY STREET	OAKLAND	CALIFORNIA 94618/USA
<b>Full Name Of Inventor</b>	<b>Family Name</b>	<b>First Given Name</b>	<b>Second Given Name</b>
	HELLER	ADAM	
<b>Residence &amp; Citizenship</b>	<b>City</b>	<b>State or Foreign Country</b>	<b>Country of Citizenship</b>
	AUSTIN	TEXAS	USA
<b>Post Office Address</b>	<b>Post Office Address</b>	<b>City</b>	<b>State &amp; Zip Code/Country</b>
	5317 VALBURN CIRCLE	AUSTIN	TEXAS 78731/USA
<b>Full Name Of Inventor</b>	<b>Family Name</b>	<b>First Given Name</b>	<b>Second Given Name</b>
	HELLER	EPHRAIM	
<b>Residence &amp; Citizenship</b>	<b>City</b>	<b>State or Foreign Country</b>	<b>Country of Citizenship</b>
	OAKLAND	CALIFORNIA	USA
<b>Post Office Address</b>	<b>Post Office Address</b>	<b>City</b>	<b>State &amp; Zip Code/Country</b>
	44 STARK KNOLL PLACE	OAKLAND	CALIFORNIA 94618/USA
<b>Full Name Of Inventor</b>	<b>Family Name</b>	<b>First Given Name</b>	<b>Second Given Name</b>
	MAO	FEI	
<b>Residence &amp; Citizenship</b>	<b>City</b>	<b>State or Foreign Country</b>	<b>Country of Citizenship</b>
	FREMONT	CALIFORNIA	PEOPLES REPUBLIC OF CHINA
<b>Post Office Address</b>	<b>Post Office Address</b>	<b>City</b>	<b>State &amp; Zip Code/Country</b>
	3805 VILLAGE TERRACE, APARTMENT #2	FREMONT	CALIFORNIA 94536/USA

Full Name Of Inventor	Family Name VIVOLO	First Given Name JOSEPH	Second Given Name A.
Residence & Citizenship	City SAN FRANCISCO	State or Foreign Country CALIFORNIA	Country of Citizenship USA
Post Office Address	Post Office Address 1548 HAIGHT STREET	City SAN FRANCISCO	State & Zip Code/Country CALIFORNIA 94117/USA
Full Name Of Inventor	Family Name FUNDERBURK	First Given Name JEFFERY	Second Given Name V.
Residence & Citizenship	City FREMONT	State or Foreign Country CALIFORNIA	Country of Citizenship USA
Post Office Address	Post Office Address 37670 CARRIAGE CIRCLE COMMON	City FREMONT	State & Zip Code/Country CALIFORNIA 94536/USA
Full Name Of Inventor	Family Name COLMAN	First Given Name FREDRIC	Second Given Name C.
Residence & Citizenship	City OAKLAND	State or Foreign Country CALIFORNIA	Country of Citizenship USA
Post Office Address	Post Office Address 13864 CAMPUS DRIVE	City OAKLAND	State & Zip Code/Country CALIFORNIA 94605/USA
Full Name Of Inventor	Family Name KRISHNAN	First Given Name RAJESH	Second Given Name
Residence & Citizenship	City FREMONT	State or Foreign Country CALIFORNIA	Country of Citizenship INDIA
Post Office Address	Post Office Address 4211 CENTRAL AVENUE, APARTMENT #1	City FREMONT	State & Zip Code/Country CALIFORNIA 94536/USA

1. ☒ Enclosed is the application; including the specification, claims, drawings, a signed oath or declaration from the prior application. The continuing application is as follows: 98 pages of specification, 17 claims, 1 page of abstract, 28 sheets of drawings, and 5 pages of oath or declaration.
- ☒ The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.
2. ☐ Cancel original claims of this application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)
3. ☒ The filing fee is calculated below:

**CLAIMS AS FILED**

NUMBER FILED	NUMBER EXTRA		RATE	FEE
TOTAL CLAIMS: 17 -20	0	x	\$18.00	0.00
INDEPENDENT CLAIMS 2 -3	0	x	\$84.00	0.00
			BASIC FILING FEE:	\$740.00
			TOTAL FILING FEE:	\$740.00



- ☐ Small entity status is claimed pursuant to 37 CFR 1.27.
4. ☒ Payment of fees:  
☒ Attached is a check in the amount of 740.00  
☐ Please charge Deposit Account No. 13-2725.
5. ☒ The Commissioner is hereby authorized to charge any additional fees as set forth in 37 CFR §§ 1.16 to 1.18 which may be required by this paper or credit any overpayment to Account No. 13-2725.
6. ☐ Amend the specification by inserting before the first line the sentence:
7. ☒ A set of formal drawings (28 sheets) is enclosed.
8. ☐ Priority of application Serial No. , filed on in , is claimed under 35 U.S.C. 119.  
☐ The certified copy has been filed in prior application Serial No. , filed .
9. ☒ The prior application is assigned of record to TheraSense, Inc. located at Alameda, California.
10. ☒ The Power of Attorney in the prior application is to:  
  
Merchant & Gould P.C.  
Minneapolis, MN 55402-2215
11. ☐ A preliminary amendment is enclosed. (Claims added by this amendment have been properly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)  
☐ Fee for excess claims is attached.
12. ☐ A petition and fee has been filed to extend the term in the prior application until . A copy of the petition for extension of time in the prior application is attached.
13. ☐ The inventor(s) in this application are less than those named in the prior application and it is requested that the following inventors identified above for the prior application be deleted:
14. ☐ A Nonpublication Request under 37 CFR 1.213(a) is enclosed.
15. ☐ Also Enclosed:
16. ☒ Address all future communications to the **Attention of Mara E. Liepa** (may only be completed by attorney or agent of record) at the address below.

17.



A return postcard is enclosed.

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903  
612.332.5300



Date:

*12 Sept 2003*

*Mara E. Liepa*  
Mara E. Liepa  
Reg. No. 40,066  
MELIEPA:rlr